

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:		)
		)
	Keith S. Boyce et al.	)
		) Art Unit
Serial No.:	10/649,323	) 2162
		)
Filed:	August 27, 2003	)
		)
Confirmation:	4564	)
		)
For:	METHOD AND SYSTEM FOR EFFICIENT	)
	COLLECTION AND STORAGE OF	)
	EXPERIMENTAL DATA	)
		)
Examiner:	Shahid Al Alam	)

DECLARATION OF DANA TANGREN

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Dana Tangren declares as follows:

1. Mr. Tangren is an attorney at the law firm of Workman Nydegger and is responsible for the prosecution of United States Patent Application No. 10/649,323 (“the ‘323 application”).
2. On March 13, 2006 the file and responsibility for the ‘323 application along with other applications owned by Cellomics, Inc. were transferred from the law firm of Lesavich High-Tech Law Group (“Lesavich firm”) to Mr. Tangren at Workman Nydegger. Attached as Exhibit A is a copy of correspondence transferring the files and responsibility. It is the understanding of Mr. Tangren that responsibility for the ‘323 application had previously been transferred from the law firm of McDonnell Boehnen Hulbert and Berghoff (“McDonnell firm”) to the Lesavich firm and

that the McDonnell firm was continuing to forward correspondence received from the United States Patent and Trademark Office to the Lesavich firm.

3. Following transfer of the Cellomics files, the Lesavich firm continued, as is customary and standard, to transfer correspondence that it received from the United States Patent and Trademark Office to Mr. Tangren at Workman Nydegger. In support thereof, attached as Exhibit B is a copy of a letter of May 3, 2006 from the Lesavich firm forwarding the filing receipt for U.S. Application No. 11/299,002.

4. On April 19, 2006 Mr. Tangren filed a Revocation and Substitute Power of Attorney in the '323 application requesting that all future communications regarding the '323 application be directed to Mr. Tangren at Workman Nydegger. Attached as Exhibit C is a copy of the Revocation and Substitute Power of Attorney.

5. On April 27, 2006 an Office Action setting forth an election of species requirement and providing a one month deadline for responding was issued in the '323 application and addressed to the McDonnell firm. Attached as Exhibit D is a copy of the Office Action.

6. Mr. Tangren declares that he did not receive a copy of the Office Action or information relative thereto from either the Lesavich firm or the McDonnell firm. Furthermore, Mr. Tangren was informed by the docketing department of Workman Nydegger that they had no record of the Office Action.

7. In November 2006, more than six months following issuance of the Office Action and thus after abandonment of the '323 application, Mr. Tangren received a telephone call from Examiner Alam, the examiner for the '323 application, asking whether a response to the Office Action had been filed. Mr. Tangren informed the examiner that he was not aware of the existence of the Office Action and that no response had been filed by Workman Nydegger. Mr. Tangren subsequently obtained a copy of the Office Action from PAIR.

8. On December 5, 2006 Mr. Tangren reported the Office Action to Cellomics, Inc. On December 20, 2006 Cellomics, Inc. replied to Mr. Tangren making an election of species. In response thereto, the present Petition is being filed concurrently with a response to the Office Action.

9. In view of the foregoing, it is submitted that the entire delay in filing the required reply for the Office Action from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

10. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated this 12<sup>th</sup> day of January 2007.

Respectfully submitted,

/Dana L. Tangren/ Reg. # 37246  
DANA L. TANGREN

Attorney for Applicant  
Registration No. 37,246  
Customer No. 022913  
Telephone: (801) 533-9800  
Fax: (801) 328-1707

# EXHIBIT A

LAW OFFICES

**LESAVICH HIGH-TECH LAW GROUP, P.C.**

Stephen Lesavich, PhD  
E-mail: lesavich@lesavich.net  
Voice: 312-332-3751

Suite 325  
39 South LaSalle Street  
Chicago, Illinois 60603  
Facsimile: 312-332-3752  
Web: www.lhtlg.com

March 13, 2006

**VIA FEDERAL EXPRESS**

**Dana L. Tangren**  
Workman Nydegger  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

**Re: Transfer of all Cellomics Files**

Dear Dana:

As of the date of this letter, the Lesavich High-Tech Law Group, P.C. is no longer responsible for any of Cellomic's intellectual property. We have ceased all work on these matters and have removed all matters from our docketing system.

Please prepare the necessary documents to revoke the Lesavich High-Tech Law Group's power of attorney and change the correspondence address for each of the files. Please notify the foreign associates that you are now responsible for any renewal/annuity fees for these matters.

Kindly acknowledge receipt of these original files by signing, dating and returning to me the enclosed copy of this letter.

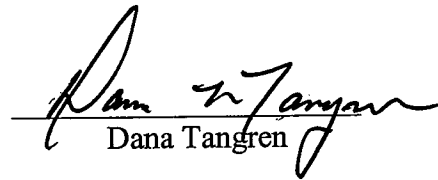
Sincerely,



**Stephen Lesavich, PhD**

c: Alan M. Doernberg, Esq.

Date: 3/14/06

  
Dana Tangren

LAW OFFICES

**LESAVICH HIGH-TECH LAW GROUP, P.C.**

Stephen Lesavich, PhD  
E-mail: lesavich@lesavich.net  
Voice: 312-332-3751

Suite 325  
39 South LaSalle Street  
Chicago, Illinois 60603  
Facsimile: 312-332-3752  
Web: www.lhtlg.com

March 7, 2006

**VIA FEDERAL EXPRESS**

**Dana L. Tangren**  
Workman Nydegger  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

**Re: Transfer of Cellomics Files – Box 3**

Dana:

This is Box 3 of 6 boxes.

This box includes the following files as identified by McDonnell Boehnen Hulbert & Berghoff docket numbers:

- ✓ 98,675-C
- ✓ 98,675-D
- ✓ 98,675-E
- ✓ 98,675-F
- ✓ 98,675-F1 10/449,323
- ✓ 98,675-G
- ✓ 98,675-G1
- ✓ 98,675-G2

I am including a copy of the docket sheet produced by MBHB on February 7, 2005.

These files include all the original correspondence as transferred from MBHB, and any additional correspondence that I received from MBHB, foreign associates, or the U.S. Patent Office. The also include correspondence that I sent out to foreign associates and the U.S. Patent Office.

CaseNumber	SubCase	WAtty	Country	ApplicationStatus	Client
98-675	F1	PMH	US	Published	CELL
<b>AppTitle</b> Method and System for Efficient Collection and Storage of Experimental Data					

CaseNumber	SubCase	WAtty	Country	ApplicationStatus	Client
98-675	G	PMH	WO	Entered Na	CELL
<b>AppTitle</b> System And Method To Achieve Integrated Presentation Of Summary Statistics, Detail Measurements, AndRaw Images While Maintaining Efficient Use Of Storage Media Through Separation Of The Data In AnThrough Separation Of The Data In An					

CaseNumber	SubCase	WAtty	Country	ApplicationStatus	Client
98-675	G1	PMH	AU	Allow to Abandon	CELL
<b>AppTitle</b> System AndMethod To Achieve Integrated Presentation Of Summary Statistics, Detail Measurements, AndRaw Images While Maintaining Efficient Use Of Storage MediaThrough Separation Of The Data In AnThrough Separation Of The Data In An					

CaseNumber	SubCase	WAtty	Country	ApplicationStatus	Client
98-675	G2	PMH	CA	Granted	CELL
<b>AppTitle</b> System And Method To Achieve Integrated Presentation Of Summary Statistics, Detail Measurements, AndRaw Images While Maintaining Efficient Use Of Storage MediaThrough Separation Of The Data In AnThrough Separation Of The Data In An					

# EXHIBIT B



LAW OFFICES

**LESAVICH HIGH-TECH LAW GROUP, P.C.**

Stephen Lesavich, PhD  
E-mail: lesavich@lesavich.net  
Voice: 312-332-3751

Suite 325  
39 South LaSalle Street  
Chicago, Illinois 60603  
Facsimile: 312-332-3752  
Web: www.lhtlg.com

May 3, 2006

**VIA FEDERAL EXPRESS**

**Dana L. Tangren**  
Workman Nydegger  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

**Re: Miscellaneous Cellomics papers**

Dana:

Here are some additional papers we received from the foreign associates with respect to Cellomics. Since your firm is now responsible for the Cellomics files, please review the papers and take the appropriate action.

Sincerely,



Stephen Lesavich, PhD

Enc. – Letters for:  
11/299,002 USPTO filing receipt  
Colb Israel patent application 142,765  
PCT/US2005/044,590 Notification Concerning Submission of Priority Document

# EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

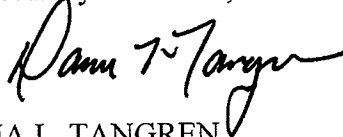
In re application of:		)
	Keith S. Boyce et al.	)
Serial No.:	10/649,323	)
Filed:	August 27, 2003	)
Confirmation:	4564	)
For:	METHOD AND SYSTEM FOR EFFICIENT COLLECTION AND STORAGE OF EXPERIMENTAL DATA	)

CERTIFICATE OF DEPOSIT UNDER 37 C.F.R. § 1.8

I hereby certify that the following documents are being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on the 19<sup>th</sup> day of April 2006.

- Revocation and Substitute Power of Attorney (2 pages)
- Postcard

Respectfully submitted,



DANA L. TANGREN  
Attorney for Applicant  
Registration No. 37,246  
Customer No. 022913  
Telephone No. 801.533.9800

DLT:dfw  
W:\16585\9\DFW0000017894V001.DOC

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Keith S. Boyce et al.

Serial No.: 10/649,323

Filed: August 27, 2003

Confirmation: 4564

For: METHOD AND SYSTEM FOR EFFICIENT COLLECTION  
AND STORAGE OF EXPERIMENTAL DATAREVOCATION AND SUBSTITUTE POWER OF ATTORNEYCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, the undersigned, states that I am Vice President of Research and Operations of CELLOMICS, INC. and that I am authorized to execute this Revocation and Substitute Power of Attorney on behalf of CELLOMICS, INC.

I further state that CELLOMICS, INC. is the assignee of the entire interest of the above-identified patent application as recorded in the United States Patent and Trademark Office at Reel 016864, Frame 0619.

The assignee, CELLOMICS, INC., hereby revokes all previous powers of attorney in the above-identified application, and now hereby appoints all attorneys under customer number

**022913**PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, Utah 84111, as attorneys with full power of substitution and revocation, to prosecute said application,

to make alterations and amendments therein, to receive the Letters Patent, and to transact all business in the Patent and Trademark Office connected therewith.


All correspondence and telephonic communications should be directed to:

DANA L. TANGREN  
WORKMAN | NYDEGGER  
Registration No. 37,246  
Customer No. 022913  
Telephone: (801) 533-9800  
Facsimile: (801) 328-1707

All previous powers of attorney are hereby revoked. For convenience and ready identification of the papers received in connection with the above-identified patent application, please change the Attorney Number to 16585.10.5.1.

Dated this 19<sup>th</sup> day of April 2006.

CELLOMICS, INC.

A handwritten signature in dark ink, reading "Jeffrey R. Haskins", is written over a horizontal line.

Jeffrey Haskins  
Vice President of Research and Operations

# EXHIBIT D



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1400  
Alexandria, Virginia 22313-1400  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,323	08/27/2003	Keith S. Boyce	MBHB 98-675-F1	4564

7590 04/27/2006  
Robert J. Irvine III  
McDonnell Boehnen Hulbert & Berghoff  
32nd Floor  
300 S. Wacker Drive  
Chicago, IL 60606

EXAMINER

ALAM, SHAHID AL

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/649,323

Applicant(s)

BOYCE ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |



### DETAILED ACTION

1. Claims 1 – 50 are pending in this Office action.

#### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

The species are independent or distinct as follow:

**Species I:** Claims 1 – 12, drawn to collecting experimental data on a computer system, comprising: initializing a container, storing configuration information and calculating and storing a plurality of container summary data in the container database.

**Species II:** Claims 13 – 26, drawn to storing experimental data comprising: collecting a plurality of image data and a plurality of feature data, creating a first database, creating a first entry in the first database linking the first database to a second database and creating a plurality of second entries in the first database linking the first database to a plurality of third database and the data is organized in a plurality of tables.

**Species III:** Claims 27 – 35, drawn to spooling experimental data comprising: copying a second database from an analysis instrument to a shared database, copying a plurality of third database from an analysis instrument to a shared database file server and updating the location of the second database.

**Species IV:** Claims 36 – 39, drawn to managing multiple database files in a database, comprising: initializing a hierarchical storage manager with a pre-determined storage removal policy, copying and storing the database files.

**Species V:** Claims 40 – 48, drawn to presenting experimental data from a plurality of database, comprising: displaying a list, receiving a first selection input, obtaining a second database for the first container, receiving a second selection and creating a graphical display.

**Species VI:** Claim 49, drawn to a data storage system, comprising: a shared database on a local area network, a hierarchical storage management system, a pass-through database and an application programming interface.

**Species VII:** Claim 50, drawn to collecting and managing experimental data, comprising: collecting a plurality of image data and feature data, storing and spooling image data and feature data and managing multiple database files in a database.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR

1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

Art Unit: 2162

must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Contact Information**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Shahid Alam*

Shahid Al Alam  
Primary Examiner  
Art Unit 2162

23 April 2006